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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/521,580

01/18/2005

Tomonori Fujisawa

IPA-005

4028

32628

7590

12/28/2009

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EXAMINER

RECEK, JASON D

ART UNIT

PAPER NUMBER

2442

MAIL DATE

DELIVERY MODE

12/28/2009

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/521,580  
Filing Date: January 18, 2005  
Appellant(s): FUJISAWA ET AL.

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Manabu Kanesaka  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed October 14<sup>th</sup> 2009 appealing from the Office action mailed October 15th 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

JP 2002-183365	Orime et al.	06-2002
US 2002/0152265 A1	Felman	10-2002

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orime et al. JP 2002-183365 A (as translated) in view of Felman US 2002/0152265 A1.

Regarding claim 5, Orime discloses "a service server" as WWW server (paragraph 21, Fig. 9), "terminal devices owned by said informing person and said informed persons connected to each other via a computer network" as an information

network connecting two parties (paragraph 21, Fig. 9), and "means for transmitting to said informed persons" as prospective clients receiving e-mail with URL (paragraph 31).

Orime also discloses "said URL having a document described with a www-compatible language" as a URL that when inputted into a Web browser will access the sever (paragraph 31), and "including a response column" as a webpage which the user can indicate if participating (paragraphs 31-32).

Orime discloses "wherein said service server comprises means for detecting data concerning said response column transmitted by each of the terminal devices owned by said informed persons, and means for transmitting a result of detection as a reporting E-mail to the terminal device owned by said informing person" as a system that sends an e-mail to the manager before the event regarding the status of the event based upon the user's responses (paragraph 33).

Orime does not explicitly disclose "wherein said reporting E-mail includes a plurality of choices for re-informing methods ... choices comprising placing a call to a first telephone number ... and placing a call to a second telephone number" however this is taught by Felman as a system that sends an email containing a telephone number (paragraph 51). Although Felman does not explicitly teach sending multiple telephone numbers this would have been obvious since the purpose of the invention to is get in contact with someone and there is a greater chance of success if all of their contact information is available.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a telephone number over email as taught by Felman for the purpose of attempting to contact an invitee who has not responded. The motivation is to allow the organizer to easily retry the users who have not confirmed. Orime teaches that meetings can be organized by telephone (paragraphs 3-4).

Regarding claim 9, the limitations that correspond to the limitations in claim 5 are rejected for the same reasons.

Orime discloses "preparing a list of informed persons not having check a transmitted message, and means for periodically reporting the list to the informing person" as transmitting an email to the manager that indicates whether to perform a meeting based on the participants response (paragraph 33).

#### **(10) Response to Argument**

Applicant's arguments have been fully considered but they are not persuasive.

(A) Applicant argues claim 5 is patentable because the combination of references does not teach all of the claim features and the combination of references is improper. In support applicant argues that Felman does not teach "placing a call to a first telephone number ..." because Felman does not suggest a system that places a call (pg. 6). This is not persuasive because applicant is arguing features not in the claims.

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Nowhere does the claim require placing a call, let alone "a system" to place a call. The specification clearly teaches that the informing person "can" contact an informing person "by selecting an appropriate" method (pg. 14 ln. 19-24). The specification further discloses that a call is placed only after the number is "clicked" (pg. 15 ln. 16-20). Thus it is clear from the claims and specification that the system does not automatically place a call as applicant asserts (pg. 6-8). Rather the claim only provides a "choice" to place a call, which is disclosed by Felman (paragraph 51) as providing a phone number via email in order to allow the user the "choice" of placing a call.

Therefore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., system automatically placing a call) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(B) Applicant argues claim 9 is patentable because Felman does not teach transmitting a reporting e-mail when the member is "not contacted" (pg. 9). Applicant's argument is misplaced. Felman was not cited for teaching transmitting a reporting email when the member is not contacted. Orime was cited as teaching this portion of the claim. Thus applicant's assertion that Felman does not teach this is irrelevant and therefore not persuasive.

Applicant concludes in a single sentence that Orime does not teach this limitation as well (pg. 9) however no reasoning is given to support this statement. Orime does teach sending a reporting email including persons that have not checked a message as discussed in the rejection above (Orime paragraphs 32-33). Orime discloses that a participant (informed persons) determines participation and this information is sent to a manager (informing person) via email (paragraphs 32-33). Thus the informing person receives an email having information about participation and nonparticipation (i.e. non responsive). Since Orime does in fact teach this claim limitation, applicant's conclusory statement is not persuasive.

For the above reasons, the rejections should be sustained.



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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

/Jason Recek/

Examiner, Art Unit 2442

Conferees:

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